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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,786	04/11/2001	David J. Diller	1073.060A	4635
23405	7590	03/09/2004	EXAMINER	
HESLIN ROTHENBERG FARLEY & MESITI PC 5 COLUMBIA CIRCLE ALBANY, NY 12203			LY, CHEYNE D	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

S/4

**Advisory Action****Application No.**

09/832,786

**Applicant(s)**

DILLER ET AL.

**Examiner**

Cheyne D Ly

**Art Unit**

1631

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 03 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☒ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-15.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: See Continuation Sheet

Applicant's summary of the telephone interview, January 06, 2004, has been accepted. The Examiner's Interview Summary has been mailed with this Office Action.

Continuation of 2. NOTE: The introduction of new limitations of "known three-dimensional structure" and "known geometry" in claims 1 and 6, lines 2 and 3; and claim 11, lines 3-4, raises new issues that would require further consideration and/or search.

The introduction of new limitations of "known three-dimensional structure" and "known geometry" in claims 1, 6, lines 2 and 3; and claim 11, lines 3-4, raises the issue of new matter.

The introduction of new limitation of "of each common core position...having a location within a predetermined distance" in claim 1, lines 10-11; claim 6, lines 9-10; and claim 11, lines 12-13, introduces a new 35 USC 112, Second Paragraph, vague and indefinite issue. Specific to the phrase "predetermined distance", said phrase causes the claims to be vague and indefinite because it is unclear as to which step previous to the step of "determining", the distance has been "predetermined" to be used in said step of "determining." Applicant asserts that said new limitation has been brought into claim 1, 6, and 11 from dependent claims 3, 8, and 13. However, the new limitation of claims 1, 6, and 11 is different from that of dependent claims 3, 8, and 13 due to the limitation of "predetermined distance" is defined (predetermined) by "the grid" which is not present in claims 1, 6, and 11.

Therefore, the new limitations cited above have not been entered.

Continuation of 3. Applicant's reply has overcome the following rejection(s): 35 USC §112, First and Second Paragraph rejections as directed to claims 1-15.

Continuation of 10. Other:  
Claim Rejections - 35 USC § 103

Claims 1, 2, 5, 6, 7, 10-12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ho et al. (1994) taken with Rarey et al. (1996).

This rejection is maintained with respect to claims 1, 2, 5, 6, 7, 10-12, and 15, as recited in the previous office action mailed December 03, 2003.

Claims 1-3, 5-8, 10-13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ho et al. (1994) taken with Rarey et al. (1996) in view of DeLisi et al. (1996).

This rejection is maintained with respect to claims 1-3, 5-8, 10-13, and 15, as recited in the previous office action mailed December 03, 2003.

Applicant's arguments are mainly directed to the deficiencies of the disclosure of Ho et al. and Rarey et al. in regard to the limitation of determining an rms by using a grid which has been found to be unpersuasive.

It is re-iterated that Ho et al. and Rarey et al. do not disclose the limitation of determining an rms by using a grid. The pointed to deficiency of Ho et al. and Rarey et al. argued by Applicant is addressed by the disclosure of DeLisi et al. It is the present of the motivation to combine the disclosure of Ho et al., Rarey et al., and DeLisi et al. as cited in the previous office action mailed December 03, 2003, which causes the claimed invention to obvious over the prior art as a whole.

It is re-iterated that DeLisi et al. discloses a method for computing the conformation and location that a protein fragment will obtain in binding to the active site by using of a grid (predetermined distance) for determining rms deviations (column 12, lines 26-64).

Claims 1, 2, 4, 5, 6, 7, 9-12, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ho et al. (1994) taken with Rarey et al. (1996) in view of Aldenderfer et al. (1984).


This rejection is maintained with respect to claims 1, 2, 4, 5, 6, 7, 9-12, 14, and 15, as recited in the previous office action mailed December 03, 2003.

Applicant's arguments are mainly directed to the deficiencies of the disclosure of Rarey et al. in regard to the limitation of clustering of data according to the rms deviation which has been found to be unpersuasive.

It is re-iterated that Ho et al. and Rarey et al. do not disclose the limitation of said clustering. The pointed to deficiency of Ho et al. and Rarey et al. is address by the disclosure of Aldenderfer et al. It is present of the motivation to combine the disclosure of Ho et al., Rarey et al., and Aldenderfer et al. as cited in the previous office action mailed December 03, 2003, which causes the claimed invention to obvious over the prior art as a whole.

It is re-iterated Aldenderfer et al. discloses a review of hierarchical clustering methods including single-linkage clustering algorithm (page 39-40).

Applicant's argument that the Office has mischaracterized the results on Table 5 (page 49) as directed to ranking based on minimum rms deviations has been found to be unpersuasive. Applicant is directed to the footnote of Table 5 (page 49) which states solution of highest rank with an rms deviation and solution with minimal rms deviations.

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER